REMARKS

Reconsideration of the application is requested.

Claims 1-19 and 21-28 are now in the application. Claims 1-19 and 21-28 are subject to examination. Claims 1-19 and 21-23 have been amended. Claims 24-28 have been added. Claim 20 has been canceled to facilitate prosecution of the instant application.

Under the heading "Claim Rejections - 35 USC § 102" on page 2 of the above-identified Office Action, claims 1-8, 12-14, 15, 16 and 18 have been rejected as being fully anticipated by U.S. Patent No. 5,519,582 to Matsuzaki (hereinafter Matsuzaki) under 35 U.S.C. § 102.

In item 5 on page 3 of the Office Action, it is appreciatively noted that the Examiner stated that claims 20-23 are allowable. The features of claim 20 have been incorporated into claim 1 and the remaining claims have been amended to be compatible with amended claim 1.

Under the heading "Claim Rejections - 35 USC § 103" on pages 2 and 3 of the above-identified Office Action, claims 9-11, 17 and 19 have been rejected as being obvious over Matsuzaki

in view of U.S. Patent No. 5,349,873 to Omura et al. (hereinafter Omura) under 35 U.S.C. § 103.

Claims 9-11, 17 and 19 ultimately depend from amended claim 1. Amended claim 1 is believed to be allowable and therefore claims 9-11, 17 and 19 are also believed to be allowable.

New claims 24-26 have been added to the application. Claim 24 is a combination of original claims 1, 3 and 9. Claim 25 corresponds to original claim 10 and claim 26 corresponds to original claim 11.

In claim 24, the first coil is disposed in a trench of a first semiconductor body and the second coil is made of a highly doped semiconductor material which is disposed in the first semiconductor body. On page 3, second paragraph of the Office Action, the Examiner argues against the patentability of such a claim. However, we respectfully disagree for the now described reasons.

With reference to Fig. 2, Matsuzaki describes a transformer configuration with two coils, which are disposed in separate semiconductor bodies. The coils are thereby each located in trenches of these semiconductor bodies. Omura describes a pressure sensor with a doped silicon layer 40, which is

disposed between a power transmission block 60 and a carrier 70. Such a pressure sensor, however, has absolutely nothing to do with a transformer so that the Examiner's argumentation, according to which a person of average skill in the art would manufacture one of the coils of highly-doped semiconductor material for the transformer of Matsuzaki in consideration of Omura, is respectfully not understood. In other words there is no hint, suggestion or incentive for the cited combination.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of

one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F-3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is respectfully requested to withdraw the rejection.

New claim 27 has been added to the application. Claim 27 is a combination of original claims 1, 3, and 8. In a transformer according to claim 27 the first and second coil are disposed in a common trench in the first semiconductor body.

Such a transformer configuration is not believed to found in any of the prior art references cited in the Office action. Such a transformer configuration can specifically not be found in the prior art reference Matsuzaki, which the Examiner refers to in view of the patentability of the present claim 8. Contrary to a transformer according to claim 27, the two coils in the component of Matsuzaki are disposed in separate semiconductor bodies and thus not on top of each other in a common trench of a semiconductor body.

New claim 28 has been added to the application. Claim 28 is a combination of original claims 1, 12 and 18. In claim 28, it is provided that the first coil is disposed in an insulation layer above a first semiconductor body and that it has a number of individual coils which are electrically connected with each other and which are disposed on top of each other. Such a configuration can also not be found in any of the prior art references cited in the Office action.

Please find enclosed a credit card authorization for $400.00 for the additional claims.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1, 24, 27 or 28.

Claims 1, 24, 27, and 28 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1 or 24.

In view of the foregoing, reconsideration and allowance of claims 1-19 and 21-28 are solicited.

If an extension of time is required, petition for extension is herewith made. Any extension fee associated therewith should be charged to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

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